

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DENNIS G. COOK SR.

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Appeal No. 97-3195  
Application 08/387,419<sup>1</sup>

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HEARD: AUGUST 2, 1999

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Before COHEN, ABRAMS and FRANKFORT, Administrative Patent Judges.  
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 7 and 9 through 17. These claims constitute all of the claims remaining in the application.

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<sup>1</sup> Application for patent filed February 10, 1995.

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Appellant's invention pertains to a divider for use in a stacking system for shipping of a product in multiple layers on a pallet and to a stacking system for a product in multiple layers on a pallet. An further understanding of the invention can be derived from a reading of exemplary claims 1, 4, and 11, copies of which appear in the APPENDIX to the main brief (Paper No. 16).

As evidence of obviousness, the examiner has applied the documents listed below:

Griffin, Jr. (Griffin)	4,000,704	Jan. 4, 1977
Sanders et al. (Sanders)	4,183,491	Jan. 15, 1980

The following rejections are before us for review.

Claims 1 through 3, 7, and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sanders.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sanders.

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Claims 4 through 6 and 11 through 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sanders in view of Griffin.

The full text of the examiner's rejections and response to the argument presented by appellant appears in the answer (Paper No. 17), while the complete statement of appellant's argument can be found in the main and reply briefs (Paper Nos. 16 and 19).<sup>2</sup>

In the "GROUPING OF THE CLAIMS" section of the main brief (page 11), appellant indicates that the rejected claims do not stand or fall together. Independent claim 1 is separately argued. However, as to independent claims 4 and 11, they are argued together. Thus, in accordance with 37 CFR § 1.192(c)(7), we select claim 4 for review, and claim 11 shall stand or fall therewith. In the argument section of the brief, the content of each of the dependent claims before us is

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<sup>2</sup> We find that the arguments advanced in the main and reply briefs lack conformance with 37 CFR § 1.192(c)(8)(iii) and (iv). For example, the arguments advanced do not comply with the requirement that specific limitations in the claims should be referenced which are not described in the prior art relied upon in the rejection.

specified without any separate argument distinguishing each dependent claim relative to the teachings of the applied prior art, e.g., on pages 15 and 16 of the main brief, only the subject matter of dependent claims 2, 7, and 9 is mentioned. Therefore, we consider each of the dependent claims on appeal to stand or fall with their respective parent claims. It follows from the above that we shall focus our attention, infra, exclusively upon independent claims 1 and 4.

#### OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellant's specification and claims 1 and 4,<sup>3</sup> the applied patents,<sup>4</sup> and the respective viewpoints of appellant and the

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<sup>3</sup> For reasons set forth in a new ground of rejection, infra, we conclude that claim 1 is indefinite. Nevertheless, we understand this claim to the extent that we can assess the merits of the examiner's rejection thereof on appeal.

<sup>4</sup> In our evaluation of the applied patents, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw

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examiner. As a consequence of our review, we make the determinations which follow.

The anticipation issue

We reverse the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Sanders. It follows that the rejection of claims 2, 3, 7, and 9 on this same statutory ground is likewise reversed since these claims stand or fall with claim 1, as earlier indicated.

Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444,

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from the disclosure. See In re Preda 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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221 USPQ 385, 388 (Fed. Cir. 1984). However, the law of anticipation does not require that the reference teach specifically what an appellant has disclosed and is claiming but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Claim 1 is drawn to a divider for use in a stacking system for shipping of a product in multiple layers on a pallet comprising, inter alia, a bottom wall having a lower surface, with a downwardly extending foot portion inboard of an edge of said lower surface, the downwardly extending foot portion being positioned at a predetermined distance inboard of the edge to allow the divider to be nested with another like divider when stacked together, such that an upwardly extending retaining wall of the another like divider supports the exterior portion of the bottom wall when nested.

We are of the view that the reinforced pallet of Sanders, with its bottom wall 12 having a top supporting surface and a

horizontal bottom (column 2, lines 2 through 8), is clearly capable of performing as a divider. Nevertheless, we find that the following claimed features are not responded to by the teaching of Sanders. Sanders does not teach a lower surface with a downwardly extending foot portion adjacent to a periphery of and inboard of an edge of the lower surface. Further, unlike the content of claim 1 that requires support at the exterior portion of the bottom wall (the part of the bottom wall beyond the downwardly extending foot portion) when like dividers are nested, it is apparent to this panel of the board that Sanders teaches a pallet with ribs 19 extending between flanges 18 and side and end walls (14, 16) at spaced points to provide nesting supports which engage the top edges of a like lower pallet as seen in Fig. 4 of the patent. Thus, limitations of claim 1 are not addressed by the teaching of Sanders. For this reason, the divider of claim 1 is not anticipated by the Sanders' patent.

The obviousness issues<sup>5</sup>

We affirm the rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Sanders in view of Griffin. The rejection of independent claim 11 and dependent claims 5, 12 through 14, 16, and 17 is also affirmed since these claims stand or fall with independent claim 4.

In rejecting claim 4, the examiner relies upon the combined teachings of Sanders and Griffin as evidence of obviousness.<sup>6</sup> Appellant asserts that the Sanders and Griffin patents do not show or suggest the "banding slots" set forth in claim 4. However, at this point, we note that the word "slots" in the

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<sup>5</sup> As earlier indicated, dependent claim 10 stands or falls with claim 1 from which it depends. We reversed the rejection of claim 1, supra. In light of the latter reversal, and the circumstance that Sanders would not have been suggestive of the divider of claim 1, it follows that the rejection of claim 10 under 35 U.S.C. § 103(a) is also reversed. The same reasoning applies to claims 6 and 15, each of which depend from claim 1. Thus, the rejection of each of these claims under 35 U.S.C. § 103(a) is reversed.

<sup>6</sup> It appears to us that claim 4 is readable on the Griffin document alone (Figs. 7 and 10, channels in reinforcing deck area ribs are banding slots), as well as on the Sanders' patent alone (Fig. 1, holes in the open grid construction can act as banding slots). Anticipation is the epitome of obviousness.



claim recitation "banding slots" may fairly be understood as broadly denoting narrow openings or grooves<sup>7</sup>.

We find that Sanders (Figs. 2 and 4) teaches a nestable and stackable reinforced plastic material pallet with handle flanges 18, and that Griffin (Figs. 8 and 9) discloses a nestable and stackable plastic material shipping pallet that includes recessed channels 52, 54 (Fig. 10) to protect strapping used to retain a palletized shipping container.

In applying the test for obviousness,<sup>8</sup> this panel of the board determines that it would have been obvious to one having ordinary skill in the art, from a combined assessment of the applied prior art, to provide the pallet of Sanders with recessed channels (slots or grooves), following the explicit teaching of Griffin. As we see it, one having ordinary skill would have

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<sup>7</sup> Webster's New Collegiate Dictionary, G. & C. Merriam Company, Springfield, Massachusetts, 1979.

<sup>8</sup> The test for obviousness is what the combined teachings of references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

clearly been motivated to make this modification simply to enhance the pallet of Sanders with a well known feature for protecting strapping that may be used therewith, as explained by Griffin.

The argument of appellant (main brief, pages 17 through 19, and reply brief, pages 6 through 8) does not persuade us of error on the part of the examiner in rejecting claim 4 under 35 U.S.C. § 103(a). Contrary to appellant's view (main brief, page 18), we earlier pointed out that the channels of Griffin fairly correspond to banding slots, as set forth in claim 4. We don't agree with appellant that the applied patents address products (pallets) different from a divider (main brief, page 19) since the pallets are capable of acting as a divider. In particular, it is noted that Griffin (Fig. 10) reveals the well known use in the art of a pallet (upper shipping tray 76) acting as a divider. We are also not in accord with the view advocated by appellant (main brief, page 19) that the references lack suggestion for the combination of their teachings. We refer to our analysis above for an understanding of the suggestion that one having ordinary skill in the art would derived from the applied teachings for their combination. Again contrary to the viewpoint set forth in

the main brief (page 23), we determine that portions of the references have not been picked and chosen based only upon appellant's own teaching. Instead, as should be evident from our discussion above, the rejection is soundly based upon suggestion from the evidence of obviousness itself, viewed as a whole.

NEW GROUND OF REJECTION

Under the authority of 37 CFR § 1.196(b), this panel of the board introduces the following new ground of rejection.

Claims 1 through 3, 6 through 10, and 15 through 17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

In claim 1, "the periphery" (line 10), "the edge" (line 11), and "the exterior portion" (line 19) of the bottom wall have no antecedent basis in the claim. In claim 6 (dependent from claim 1), "the periphery" of the bottom wall (line 3) lacks an antecedent basis. In claim 4, "its periphery" (lines 2 and 3), referring to the bottom wall, and "the periphery" of the lower surface (lines 5 and 6) each lack an antecedent basis. Claim 17

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depends from independent claim 4. However, neither claim 4 nor claim 17 has an antecedent basis for "said upwardly extending retaining wall" (claim 17, lines 2 and 3).

In summary, this panel of the board has:

reversed the rejection of claims 1 through 3, 7, and 9 under 35 U.S.C. § 102(b) as being anticipated by Sanders;

reversed the rejection of claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Sanders; and

affirmed the rejection of claims 4, 5, 11 through 14, 16, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Sanders in view of Griffin, but reversed the rejection of claims 6 and 15 on the same statutory ground.

Additionally, we have introduced a new ground of rejection pursuant to 37 CFR § 1.196(b).

The decision of the examiner is affirmed-in-part.

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In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

AFFIRMED-IN-PART  
37 CFR § 1.196(b)

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
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CHARLES E. FRANKFORT	)	
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